28 (amend d). The device as claimed in claim 10, wherein the composition [comprises] consists essentially of:

- 80 to 90% of hexamethyldisiloxane,
- 0.1 to 5% of the therapeutic agent or cosmetic substance,
- 1 to 10% of the thixotropic agent, and
- 0 to 20% of fillers or additives.

REMARKS

The present claims are 10-17 and 23-28.

The claims are amended, hereby, such that the transitional phrase following the "composition" recited in the claims is changed from "comprising", or "comprises", to "consisting essentially of," or "consists essentially of." In accordance with this change, the present claims exclude from the recited "composition" any non-recited elements that would materially affect the basic and novel characteristics of the present invention. The significance of this change in the claims is discussed further, below, in conjunction with the prior art rejection of the claims.

Claim 27 is amended, hereby, to depend from claim 23, rather than claim 22, and to incorporate the subject matter of previously cancelled claim 22.

Claims 25 and 26 are amended, hereby, in order to correct clerical errors that occurred in Applicant's Amendment submitted on October 7, 1996. In this previous Amendment, claims 25 and 26 were intended to be amended by changing the dependency of each claim to claim 23, and to incorporate subject matter from the original parent claims, which had been cancelled. In drafting the respective claim amendments, however, the subject matter that was incorporated into each of claims 25

and 26 did not correspond with each of the original parent claims in each case. In accordance with the present Amendment, claim 25, now, includes the subject matter taken from cancelled parent claim 20, and claim 26, now, incorporates subject matter from cancelled parent claim 21.

By the present Amendment, the title has been changed in accordance with the requirement set forth in the outstanding Office Action.

The present claims stand rejected under 35 U.S.C. §103 as being allegedly unpatentable based on McCrea. Reconsideration is requested in view of the present Amendment, by which the composition recited in the present claims consists essentially of the recited components.

McCrea teaches a composition for topical administration. The composition is disclosed to contain "an improved suspending agent comprising a finely-divided silica and a suspending wax composition" (McCrea, Abstract). The suspending wax composition must include a "hard" wax (having a melting point above 150°F), such as Castor wax, beeswax, and carnauba wax (McCrea, Col. 12, ls. 30-42). The particular wax used must be able to be "incorporated into the paste-like suspending wax composition". (McCrea, Col. 13, ls. 9-12).

In accordance with the presently claimed invention, the claimed "container" and "method of skin treatment" include a composition consisting essentially of the recited composition ingredients. As explained, above, the phrase consisting essentially of excludes from the composition any non-recited elements that would materially affect the basic and novel characteristics of the claimed invention Therefore, the present claims, as amended hereby, do not read on a device that contains, or a method that uses, a

composition that includes any ingredients that would adversely affect the ability of the present invention to work for its intended purpose. In re Janakirma-Rao, 137 U.S.P.Q. 893 (CCPA 1963).

The present claims exclude the composition of McCrea because the McCrea composition is a wax-containing suspending wax composition. The suspending wax composition disclosed in McCrea, which is an essential feature of the McCrea invention, would adversely affect the ability of the presently claimed invention to work for its intended purpose. That is, the presently claimed invention involves a method for "spraying on the skin" (emphasis added), and a device "for dispensing a composition onto the skin in the form of aerosol particles" (emphasis added). In order for the presently claimed invention to work for its intended purpose, the "composition" recited in the claims must be suitable for "spraying" and for "dispensing" as "aerosol particles." The "suspending wax composition" essential in the McCrea topical composition would render a material too pasty (or waxy) to be suitable for "spraying" or forming into "aerosol" particles. That is, it would adversly affect the material from working as a spray or as aerosol particles.

Accordingly, even assuming, *arguendo*, that McCrea were modified in the manner suggested in the outstanding Office Action, the present claims would not read on the modified McCrea teachings. Therefore, the presently claimed invention would not have been obvious based on McCrea.

Applicants further observe that the teachings of McCrea cannot be applied to the present claims in an obviousness analysis in any way that removes the "suspending wax composition" from the teachings against which the present claims are applied. The

"suspending wax composition" is the critical element of the McCrea invention because it "effectively helps disperse and suspend the topically-active compound" in order "to provide an essentially syneresis-free, topically-effective composition" (McCrea, Col. 14, ls. 46-51). Since removing the "suspending wax composition" from the topical composition of McCrea would destroy the McCrea invention, McCrea cannot be applied against the present claims in an obviousness analysis unless the "suspending wax composition" is included as part of McCrea's teachings. Ex parte Hartmann, 186 U.S.P.Q. 366 (P.O. Bd. App. 1974). The PTO cannot use a prior art invention in an obviousness analysis in such a way that "it would be rendered inoperable for its intended purpose." In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed.Cir. 1984).

Favorable action commensurate with the foregoing is requested.

Respectfully submitted,

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